

Remarks

Reconsideration and allowance in view of the foregoing amendments and the following remarks are requested. Claims 1-5, 7-8, and 11 were pending in this application. By this amendment, Applicants have amended claims 1, 4, 5, 7, 8, and 11 and added new claims 12-16, which read on the elected invention. Claims 2 and 3 are cancelled and their limitations incorporated into claim 1. Claims 6, 9, and 10 were withdrawn as being directed to a non-elected species. Thus, claims 1, 4-5, 7-8, and 11-16 are pending in the application. Support for the amendments can be found in the original claims. No new matter has been added by the amendments. Applicants respectfully request reconsideration of the claims.

The abstract of the disclosure was objected to because of the use of legal phraseology. An amended abstract has been substituted above to correct these issues.

Claims 1-5, 7-8, and 11 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite and failing to particularly point out and distinctly claim the subject matter which the applicant regards as the invention. Claims 2-3 have been cancelled rendering these claim rejections moot. Claims 1, 4-5, 7-8, and 11 have been amended to overcome the rejections. Specifically, the phrase "can be" has been removed by the amendments to claims 1 and 5. The term "preferably" has been removed by the amendments to claim 4. The phrase "approximately parallel" has been removed by the amendments to claims 5 and 7. Furthermore, the claim amendments generally more clearly define the invention.

Claims 1-2, 4-5, and 8 were rejected under 35 U.S.C. § 102(b) as being anticipated by EP 0924503 ("the '503 application"). Claim 2 has been cancelled rendering that claim objection moot. Claim 1, as amended, requires a device comprising a cutter, a cutter holder, and a

piezoelectric element. The cutter is fastened to the piezoelectric element, which in turn is fastened to the cutter holder. Importantly, the cutter is supported in the cutter holder exclusively by the piezoelectric element, being otherwise freely suspended on the cutter holder. The device disclosed in the '503 application, shows the piezoelectric element connected to the cutter holder, but not connected to the cutter. The '503 application does not show a cutter exclusively supported by the piezoelectric element as is required by claim 1, as amended. Applicants respectfully submit that the '503 application does not and can not anticipate each and every element of amended claim 1.

Claims 4-5 and 8 were also rejected under 35 U.S.C. § 102(b) as being anticipated by the '503 application. Claims 4-5 and 8 depend from claim 1 which, as explained above, is believed to be allowable. Thus, claims 4-5 and 8 are submitted to be allowable as depending from an allowable base claim.

Claims 1, 3, and 7 were rejected under 35 U.S.C. § 102(b) as being anticipated by DE 3820085 ("DE '085"). Claim 3 has been cancelled rendering that claim objection moot. The Examiner alleges that DE '085 discloses a cutter (e.g., 18), a cutter holder (e.g., 12), and a piezoelectric element (e.g., 42). In all of the embodiments shown in DE '085, the cutter is connected to both the piezoelectric element and the cutter holder and therefore the cutter is not exclusively supported by piezoelectric element and freely suspended on the cutter holder as is required by amended claim 1. Applicants respectfully submit that DE '085 does not and can not anticipate each and every element of amended claim 1.

Claim 7 also stands rejected under 35 U.S.C. § 102(b) as being anticipated by DE '085. Amended claim 7 depends from claim 1 which, as explained above, is believed to be allowable. Thus, amended claim 7 is submitted to be allowable as depending from an allowable base claim.

Claim 11 was rejected under 35 U.S.C. § 103(a) as obvious over DE '085 and the knowledge of one having ordinary skill in the art. As discussed above, with respect to the rejection of claim 1 under 35 U.S.C. § 102(a) as anticipated over DE '085, DE '085 does not and can not anticipate each and every element of amended claim 1. Amended claim 11 depends from claim 1 which, as explained above, is believed to be allowable. The knowledge of a person having ordinary skill in the art does not remedy the deficiencies in DE '085 with respect to claim 1. Thus, the combination of DE '085 in view of the knowledge of a person having ordinary skill in the art fails to disclose or suggest each and every element of claim 11, and the rejection of this claim is improper. Accordingly, Applicants respectfully request that the rejection of claim 11 be withdrawn.

All of the stated grounds of objection and rejection have been properly traversed, accommodated, or rendered moot. Applicant therefore respectfully requests that the Examiner reconsider all presently outstanding objections and rejections, and that they be withdrawn. Applicant believes that a full and complete reply has been made to the outstanding Office Action and, as such, the present application is in condition for allowance.

If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

In the event that this paper is not timely filed, the Applicant respectfully petition for an appropriate extension of time. Any fees for such an extension together with any additional fees may be charged to Counsel's Deposit Account No. 02-2135.

Respectfully submitted,

By: _____



G. Franklin Rothwell
Registration No. 18,125
Ryan P. Wallace
Registration No. 60,212
Attorneys for Applicant
ROTHWELL, FIGG, ERNST & MANBECK, P.C.
Suite 800, 1425 K Street, N.W.
Washington, D.C. 20005
Telephone: (202) 783-6040